

REMARKS

The applicants have studied the Office Action dated March 8, 2005. It is submitted that the application is in condition for allowance. Claims 12 has been amended. Reconsideration and allowance of all of the claims in view of the following remarks are respectfully requested.

Claims 12-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shimanuki, US Patent Number 5,890,071 (hereinafter Shimanuki) in view of Applicant's Admitted Prior Art (AAPR).

Claim 12 recites "A method for processing received audio signals in a device, the method comprising: disabling a first channel in a receive audio processing path and enabling a second channel in the receive audio processing path when the audio signals comprise mono signals; and enabling the first channel in the receive audio processing path and enabling the second channel in the receive audio processing path when the audio signals comprise stereo signals." The references cited by the Examiner do not disclose disabling and enabling a first and second channels in a receive audio processing path based on whether the audio signal is a mono signal or a stereo signal, as recited in the claims,

In the Shimanuki reference, the "controller 11 controls the power supply switch 22 to turn on and off in synchronism with the operation cycle of the receiver 2" to save electric power. (See col. 4, lines 36-43 of the reference). However, when a user turns on the tuner section while the receiver 2 is operating, the controller 11 turns on the power switch to supply 23 to supply power to the tuner section and at the same time, causes the switch 22 to stop its on-off operation and remain on. (See col. 4, lines 36-52 of the reference). But, when the tuner section is turned off by the user, the controller 11 turns off the switch 23 to stop supplying power to the tuner section and resumes "the on-off control over the power supply switch 22 intermittently supply electric power to the telephone section for power saving." (See col. 4, lines 53-65 of the reference). Thus, the sections of the Shimanuki reference pointed out by the Examiner only discloses that when a user turns on the tuner section while the receiver 2 is operating, the controller 11 turns on the power switch to supply 23 to supply power to the tuner section and at the same time, causes the switch 22 to stop its on-off operation and remain on.

As admitted by the Examiner, the Shimanuki reference does not disclose having a receive audio processing path having a first channel and a second channel. Furthermore, the Shimanuki reference does not disclose enabling/disabling one of the channels based on whether the audio signal is a mono signal or a stereo signal.

The Examiner states that AARP discloses that "the plurality of components may be in either a right or left channel of the receive audio processing path." However, the Federal Circuit has provided that an Examiner must establish a case of *prima facie* obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

Moreover, there must be some motivation or suggestion in the prior art to come up with the claimed invention. For example, the Court in In re Semaker, 217 USPQ 1, 6 (Fed. Cir. 1983) declared:

"The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings."

The Shimanuki reference does not suggest having a receive audio processing path having a first channel and a second channel. Furthermore, the Shimanuki reference does not suggest enabling/disabling one of the channels based on whether the audio signal is a mono signal or a stereo signal. Without the teaching or suggestion of a receive audio processing path having a

first channel and a second channel or enabling/disabling one of the channels based on whether the audio signal is a mono signal or a stereo signal, it is respectfully submitted that the Examiner is engaging in hindsight reconstruction of the claimed invention. The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). Thus, it is clear that the Examiner is relying on impermissible hindsight to avoid express limitations in the claims and come up with unsupported and hypothetical teachings to thereby recreate the applicants' claimed invention.

Furthermore, the AARP does not address the deficiencies of the Shimanuki reference since AARP does not disclose enabling/disabling one of the channels based on whether the audio signal is a mono signal or a stereo signal.

Thus, claim 12-21 distinguish over the art of record.

Therefore, it is respectfully submitted that the rejection of claims 12-21 under 35 U.S.C. §103(a) should be withdrawn.

The applicant thanks the Examiner for allowing claims 1-11.

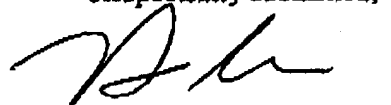
In view of the foregoing, it is respectfully submitted that the application and all of the claims are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If there are any fees due in connection with the filing of this response, please charge such fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for, such an extension is requested and the fee should also be charged to our Deposit Account. A duplicate copy of this page is enclosed.

Respectfully submitted,

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